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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,510	12/12/2003	Allan Svendsen	5618.520-US	2614

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EXAMINER

SAIDHA, TEKCHAND

ART UNIT PAPER NUMBER

1652

DATE MAILED: 07/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/734,510	<b>Applicant(s)</b> SVENDSEN ET AL.	
	<b>Examiner</b> Tekchand Saidha	<b>Art Unit</b> 1652	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 19 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 19 June 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: 105-120 and 122-135.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: 121.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Office Action.  
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
 13. ☐ Other: \_\_\_\_\_.

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**Advisory Action**

1. Applicants' amendment After-Final Office Action, filed June 19, 2006 is acknowledged. Claims 1-104 have been cancelled.
2. Claims 105-135 are pending and under consideration in this examination.
3. Applicant's arguments filed December 22, 2005 have been considered and not found to be persuasive. The reasons are discussed following the rejection(s).
4. Any objection or rejection of record which is not expressly repeated in this Office Action has been overcome by Applicant's response and withdrawn.
5. Applicants have provided the required statement under 37 C.F.R. 1.808; as well as the catalog reference of the availability of the microbial strains for CBS 116.46, 74338; NRRL B-21527; CBS 100231 & CBS100232. Therefore, the claim rejection under - 35 U.S.C. § 112 (deposit requirement), is withdrawn.

6. ***Claim Rejections - 35 U.S.C. § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claim 121 is rejected under 35 U.S.C. 102(e) as being anticipated by Lassen et al. [U.S.P. 6,060,298]. Lassen et al. teach *Peniophora* phytase sequence (SEQ ID NO : 2) which is 100% to Applicants' SEQ ID NO : 7.

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In claim 121, there are modified positions which read upon the native *Peniophora* phytase sequence disclosed by Lassen et al. because the modification/substitution is with the same amino acid present in the native sequence, amounting to no modification at all. The mutational positions are 75W (Trp), 78S (Ser) and 84Q (Glu) corresponding to SEQ ID NO : 7. No difference is seen between the claimed method of modified sequence and that of a method of making the wild-type, as shown in the prior art of Lassen et al. The reference anticipates the claim.

7.

**Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claim 121 is rejected under the judicially created doctrine of double patenting over claims 1-3 of U. S. Patent No. 6,060,298 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Claim 121 is anticipated by claims 1-3 of U. S. Patent No. 6,060,298, as explained above in the 102 rejection.

Applicants argue that Lassen et al. do not teach or suggest methods of producing a modified phytase, comprising introducing a mutation at one or more positions [selected from a group consisting of] - 71, 72, 73, .....120.

Applicants' attention is drawn to the rejections - which refer to the method of making specific mutational modifications at positions 75W (Trp), 78S (Ser) and 84Q (Glu) corresponding to SEQ ID NO: 7.

According to the claimed method the parent or wild type sequence of mature *Peniophora lycii* phytase of SEQ ID NO: 7 is modified and the resultant modifications as claimed are 75W (Trp), 78S (Ser) and 84Q (Glu). The unmodified SEQ ID NO: 7 at the specific positions are the same, viz., W75, S78 & Q84. Therefore modifying the specific positions with the same amino acid - such as W75W, S78S & Q84Q, is no modification at all, and the sequence is reverting back to the wild-type. Hence, no difference is seen between method of making wild-type *Peniophora lycii* phytase and the instant modified phytase.

8. Claims 105-120 & 122-135 are allowed.

9. Status of the claims:

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Claim 121 is rejected.

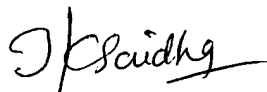
Claims 105-120 & 122-135 are allowed.

10. No new arguments are presented nor explanation provided why substitution of an amino acid with the same amino acid will result in a phytase distinct from that of native *Peniophora* phytase.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tekchand Saidha whose telephone number is (571) 272 0940. The examiner can normally be reached on 8.30 am - 5.00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on (571) 272 0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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